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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/647,116

08/25/2003

Kevin RJB Donovan

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26192 7590 10/28/2008  
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EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3688

NOTIFICATION DATE

DELIVERY MODE

10/28/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/647,116	<b>Applicant(s)</b> DONOVAN ET AL.	
	<b>Examiner</b> Raquel Alvarez	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 19-21 and 31-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 22-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 19-21 and 31-65 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/4/03, 5/16/05, 11/16/05, 12/6/05</u> .                     | 6) <input type="checkbox"/> Other: _____                          |



### **DETAILED ACTION**

1. This office action is in response to communication filed on 7/3/2008.
2. With respect to the restriction requirement, Applicant has elected Group I, consisting of claims 1-9, 10-18 and 22-30.
3. New claim listing has to be provided indicating the withdrawn claims, according to 37 CFR 1.111.

#### **Claim Rejections - 35 USC § 112**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 11 doesn't further limit claim 10 from which it depends from. Correction is required.

#### **Claim Rejections - 35 USC § 102**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 9, 22 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Emens et al. (7,076, 443 hereinafter Emens).

With respect to claims 1, 9, 22 and 30, Emens teaches a computerized advertisement distribution and delivery system for dynamically delivering advertisements for inclusion in an electronic document delivered to and stored at a recipient system (Abstract).

Advertisement image generation means for generating an image containing a plurality of advertisements related to a specific distribution subject based on a relationship between those advertisements and storing that image in association with a network-based locator as being the up-to-date image for the specific distribution subject (i.e. product icons 69)(Figure 2); advertisement relationship determination means for intermittently determining relationships between advertisements related to a specific distribution subject and if an existing relationship between advertisements related to a specific distribution subject changes, initiating the advertisement image generation means to generate a modified up-to-date image stored in association with the network-based locator and specific distribution subject (i.e. the product icons are based on the advertisements to be displayed which are based on the user's search results)(Figures 1 and 2); electronic document transmission means for creating and transmitting an electronic document containing content related to a specific distribution subject and a

network-based locator associated with the image generated by the advertisement image generation means for the specific distribution subject (product icons and search results are displayed to the user); and advertisement image transmission means for receiving a request for the image located at the network-based locator specified in the electronic document transmitted by the electronic document transmission means and transmitting the up-to-date image stored in association with the network-based locator at the time the request is received (i.e. the user clicks on the product icons(see col. 6, lines 12-17).

**Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-8, 10-18, 23-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens in view of Clarke (7,062,453 hereinafter Clarke).

Claims , 2, 4, 6-8, 10-18, 23, 25, 27-29, further recite a bid representing an amount to be paid for click-throughs by end-user recipients to target site associated with the advertisement. Clarke teaches on Figure 5A, advertisers entering a "bid" which is the amount of money that the advertisers pay when a user clicks on their listing. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the invention of Emens the teachings of Clarke of a bid representing an amount to be paid for click-throughs by end-user recipients to target

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site associated with the advertisement because such a motivation would allow for the highest bidder to be selected.

Claims 3, 5 and 24, 26 further recite grouping advertisements based on the highest revenue efficiency. Clarke teaches highest revenue efficiency advertisements. The combination of Emens and Clarke do not teach grouping advertisements. Official Notice is taken that it is old and well known to group items with similar characteristics. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included grouping advertisements based on the highest efficiency in order to get the highest revenues.

**Point of contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James w. Myhre can be reached on (571)272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/  
Primary Examiner, Art Unit 3688

Raquel Alvarez  
Primary Examiner  
Art Unit 3688

R.A.  
10/17/2008